

## REMARKS

The present response is submitted in reply to the Final Office action which was issued on June 11, 2009. Claims 1-16 are pending in this application. Claims 1-11 and 14-16 are rejected and claims 12-13 are withdrawn. Reconsideration is respectfully requested in light of the amendments being made hereby and of the following remarks.

No new matter has been added.

### Rejection of claims 1-5 and 14-16 under 35 U.S.C. 103(a)

Claims 1-4, 6-11 and 14-16 are again rejected under 35 U.S.C. 103(a) as being unpatentable over WO 89/00106 (Plamthottam, et al.) in view of U.S. Publication No. 2004/0219356 (Valdez). The Examiner states that Plamthottam, et al. teach a self-adhesive, flexible sealing tape comprising at least one flexible, self-adhesive core/carrier layer provided with an envelope/two-sided coating comprising a second adhesive system wherein the envelope/coating comprises an expanded pressure-sensitive adhesive tape, and that the material for the core/carrier layer is selected from the group consisting of thermoplastic rubbers on the basis of styrene-isoprene-styrene block copolymers, styrene-butadiene-styrene block copolymers, copolymers of vinyl acetate and acrylates thermally cross-linked as in claim 1. The Examiner further states that Plamthottam, et al. teach the remaining limitations of the present claims, except for the envelope/two-sided coating completely surrounding at least one carrier-core layer, the envelope/coating having a foam-like structure, the sealing tape being equipped with reinforcing elements which stabilize the sealing tape in the longitudinal direction, the reinforcing element being selected from the group consisting of threads, nonwovens or interlaid scrims, wovens,

knitted fabrics and crocheted fabrics, and the tape is used for adhesively bonding vapour barrier films or vapour retarder films by adhesively bonding the films to walls.

The Examiner relies on Valdez for teaching an adhesive tape with an envelope/coating having a foam-like structure and being equipped with reinforcing elements which stabilize the sealing tape in the longitudinal direction, and where the reinforcing element is selected from the group consisting of threads, nonwovens and wovens for forming a tape that can withstand humidity and extreme temperatures without suffering from disintegration. The Examiner concludes that it would have been obvious to have provided the foam tape with the stabilizing structure in Plamthottam, et al. in order to form a tape that can withstand humidity and extreme temperatures without suffering from disintegration, as taught by Valdez.

Regarding the limitation “the tape is used for adhesively bonding vapour barrier films or vapour retarder films, by adhesively bonding said films to walls,” the Examiner states that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. The Examiner thus concludes that since the prior art structure is capable of performing the intended use, it meets the present claim.

Regarding the limitation “the envelope/two-sided coating completely surrounding at least one carrier/core layer,” the Examiner states that Plamthottam, et al. disclose that the layers of the adhesive tape are extruded together to form the tape. Thus, the Examiner’s position is that it would have been obvious to one of ordinary skill in the art

to change the shape of the layers to surround the core since it requires only a change in shape.

Claim 5 has again been rejected as being unpatentable over Plamthottam, et al. in view of Valdez, and further in view of U.S. Patent No. 3,297,846 (Peltier). The Examiner states that Plamthottam, et al. and Valdez teach the presently claimed invention, except for the pressure-sensitive adhesive tape comprising an adhesive base on a material selected from the group consisting of vinyl isobutyl ether and isobutene. The Examiner refers to Peltier for teaching a self-adhesive, flexible sealing tape comprising at least one flexible, self-adhesive core or at least one flexible, self-adhesive carrier layer provided with an envelope or two-sided coating comprising a second adhesive system wherein the envelope/coating comprises an expanded pressure-sensitive adhesive tape and wherein the pressure-sensitive adhesive tape comprises an adhesive based on a material selected from the group consisting of vinyl isobutyl ether and isobutene for attaching the tape to a surface. The Examiner concludes that it would have been obvious to one skilled in the art to have provided the adhesive in the modified Plamthottam, et al. product in order to attach the tape to a surface as taught by Peltier.

The Applicants respectfully submit that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitation. Moreover, the prior art must not teach away from the present invention. The Applicants respectfully submit that

one skilled in the art would have no suggestion or motivation to combine the aforementioned references in order to arrive at the presently claimed invention. Additionally, even if one skilled in the art were to consider the combination of teachings, each and every limitation of the present invention would not be disclosed, nor would there be a reasonable expectation of success if the aforementioned references were to be considered.

The Applicants disagree with the Examiner's conclusion set forth in the Final Office action. It is noted that the Examiner has acknowledged that the presently claimed invention, as defined in claim 1, is distinguished from Plamthottam, et al. in that the cited reference fails to disclose that the envelope/two-sided coating has a foam-like structure. Regarding this limitation, it is noted by the Examiner in the Final Office action on page 3 that Valdez discloses an adhesive tape with an envelope/coating having a foam-like structure.

In this regard, the Applicants respectfully disagree that one skilled in the art would be motivated to modify the envelope/coating of the adhesive tapes of Plamthottam, et al. with a foam-like structure of Valdez. In particular, while the Examiner has provided an explanation on the motivation for providing tapes of Plamthottam, et al. with reinforcing elements and for making the envelope/two-sided coating completely surrounding the carrier/core layer, it is respectfully submitted that there would be no such motivation with respect to the present limitation "envelope/coating has a foam-like structure." Therefore, it is submitted that one skilled in the art would not have been motivated to modify the teachings of Plamthottam, et al. with those of Valdez to arrive at the presently claimed

invention.

The Applicants also submit that present claim 1 does not require the envelope/coating to have a foam-like structure, but rather recites that the envelope/coating comprises an expanded (emphasis added) pressure-sensitive adhesive tape. The “foam-like structure” is recited in dependent claim 9. The limitations “expanded” and “foam-like” are not identical or equivalent. A foam-like structure is not necessarily an expanded structure, as it may be provided, for instance, by incorporating rigid microspheres as taught by Plamthottam, et al. On the other hand, an expanded structure is not necessarily a foam-like structure (see present specification, paragraph [000021]: “...has a foam-like structure...”; present claim 9).

The Examiner has merely pointed out that Valdez teaches an adhesive tape with an envelope/coating having a foam-like structure. However the Examiner has failed to provide any argument relating to the limitation “expanded pressure-sensitive adhesive tape” which is recited in present claim 1 and which is different from the limitation “foam-like structure” of present claim 9.

Further, in the adhesive tape of Plamthottam, et al., it is the core/carrier layer, rather than the envelope/coating, which has a foam-like structure (see, for example, claim 1 therein). Therefore, this situation of Plamthottam, et al. is not comparable to that of the presently claimed adhesive tape. It is submitted that in this regard, Plamthottam, et al. would teach away from the presently claimed invention. Moreover, Plamthottam, et al. expressly teaches that the skin layer (envelope) is free of microspheres (page 3, lines 16-19).

Since the teachings of Plamthottam, et al. are clearly opposed to what is claimed by the present invention, the secondary reference would be required to provide a clear teaching regarding the relative position of the foamed structure (i.e., whether it is in the core/carrier or in the envelope/coating). However, Valdez fails to provide such a clear teaching. Since paragraph [0045] (page 4, quoted in the present Office action) does not refer to a tape having a core-envelope structure as presently claimed, this teaching should not be regarded as being suitable for overcoming the fact that Plamthottam, et al. teaches away from the presently claimed invention. Therefore, based on Valdez, it would not be obvious to provide the envelope/coating with a foamed structure, rather than the core/carrier layer.

Generally, the adhesive tapes disclosed by Valdez do not comprise a carrier or core layer, as is expressly stated in paragraph [0052], page 4 (“...does not include an intermediate layer.”). Due to the absence of a carrier, it is impossible to identify a layer that might correspond to the coating/skin layer of Plamthottam, et al. (or to the envelope/coating of the presently claimed adhesive tapes).

Regarding the limitation of present claim 14, the Examiner states (at page 4, first paragraph of the Office action) that the prior art structure would be able to perform the intended use (i.e., “adhesively bonding said films to walls”). The Applicants respectfully disagree with this conclusion since the adhesive tapes of the present invention are capable of conforming themselves to the rough surface of the substrate, e.g., a wall, is due to the presence of an expanded pressure-sensitive adhesive in the envelope layers (see, for example, present specification, paragraphs [000021], [00009]). Since the outer coatings

of the tapes disclosed in Plamthottam, et al. do not comprise an expanded adhesive, these cannot be assumed to be capable of adapting themselves to a rough surface, e.g., a wall.

In addition, based on the introductory section of Plamthottam, et al., it appears that this document generally does not relate to adhesive tapes that are intended for being used on rough surfaces, e.g., walls of buildings.

Regarding the rejection of claim 5, the claim relates to the polymer composition of the expanded adhesive tape which constitutes the envelope/coating (original description, page 5, first and second paragraphs). Peltier discloses an adhesive layer formed from plasticized polyisobutylene. However, this is no indication whether this polymer type would be suitable for producing an expanded envelope/coating layer as recited in present claim 1. Therefore, using such polymer for producing an expanded adhesive layer would not be obvious to one skilled in the art.

Moreover, the Applicants submit that the alleged modification would not be obvious based on Plamthottam, et al. since there is no clear teaching as to whether polyisobutylene should be included in the carrier layer or coating layers (none of these layers are “expanded” as explained above). It is further noted that “vinyl isobutyl ether,” which is also recited in claim 5, is not taught by Peltier.

In view of the numerous deficiencies of Plamthottam, et al., the reference, alone or in combination with the other cited prior art, simply fails to teach and/or disclose each and every limitation of the presently claimed invention. Moreover, the reference teaches away from the presently claimed invention as discussed above. In addition, the secondary references fail to make up for any of the numerous deficiencies of Plamthottam, et al. In

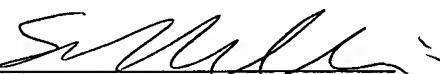
conclusion, it is respectfully submitted that one skilled in the art would not have considered combining the teachings of the cited prior art to arrive at the presently claimed invention, and even if such combination were performed, would not yield each and every limitation of the present claims. Withdrawal of these rejections is strongly requested.

**Conclusion**

In light of the foregoing claims and arguments, it is believed that the present application is in condition for allowance, and such action is earnestly solicited. The Examiner is invited to call the undersigned if there are any remaining issues to be discussed which could expedite the prosecution of the present application.

Respectfully submitted,

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